



Paper No. 6

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OFFICE OF PETITIONS

In re Application of :
McCarthy & Ingram :
Application No. 09/809,429 : DECISION REFUSING STATUS
Filed: 16 March, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 111472.120US1 :

This is in response to the petition filed under 37 CFR 1.47(a) on 17 December, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 16 March, 2001, without an executed oath or declaration. Accordingly, on 17 May, 2001, Initial Patent Examination Division mailed a "Notice to File Missing Parts of Nonprovisional Application" requiring the statutory basic filing fee, additional claim fee(s), an executed oath or declaration, and a surcharge for their late filing.

In response, on 17 December, 2001, petitioners filed a request

and payment for a five (5) month extension of the time to reply to the aforementioned Notice, accompanied by an executed declaration naming Peter J. McCarthy and Kevin Ingram as joint inventors and signed by joint inventor McCarthy on behalf of himself and joint inventor Ingram, and the requiring filing fees, surcharge, and petition fee.

Petitioners assert that Ingram was sent a draft application but failed to sign and return the declaration, which was subsequently sent to him.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). In regards to item (1), petitioners have not submitted sufficient evidence to prove that a copy of the application as filed (specification including claims, drawings if any, and the declaration) was sent or given to the non-signing inventors. The affidavit of petitioner's registered patent attorney, Gregory S. Discher, states that a "first draft" of the application was sent to TruMarkets, the assignee, and that the declaration was subsequently sent to Ingram. Thus, petitioners have not shown that the application papers were ever sent or given to Ingram.

Petitioners should send a copy of the application (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor at his last known address with a request that he sign and return the declaration. Petitioners may show proof by providing a copy of the cover letter transmitting the application papers to the non-signing inventor or provide details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Petitioners must also present proof that the non-signing

inventors refuse to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy